

**TRANSMITTAL OF APPEAL BRIEF**Docket No.
HOK-9022/CON

In re Application of: Takuya Matsumoto et al.

Application No.
10/718,660-Conf. #1610Filing Date
November 24, 2003Examiner
D. ChampagneGroup Art Unit
3622

Invention: SYSTEM AND METHOD OF ARRANGING DELIVERY OF ADVERTISEMENTS OVER A NETWORK SUCH AS THE INTERNET

TO THE COMMISSIONER OF PATENTS:Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: June 13, 2006The fee for filing this Appeal Brief is \$ 250.00☐ Large Entity☒ Small Entity☒ A petition for extension of time is also enclosed.The fee for the extension of time is \$ 60.00☐ A check in the amount of _____ is enclosed.☒ Charge the amount of the fee to Deposit Account No. 18-0013
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Docket No.: HOK-9022/CON
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Takuya Matsumoto et al.

Application No.: 10/718,660

Confirmation No.: 1610

Filed: November 24, 2003

Art Unit: 3622

For: SYSTEM AND METHOD OF ARRANGING
DELIVERY OF ADVERTISEMENTS OVER A
NETWORK SUCH AS THE INTERNET

Examiner: D. Champagne

APPELLANT'S BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an Appeal Brief under 37 C.F.R. §41.37 appealing the final decision of the Examiner dated January 13, 2006. Each of the topics required by 37 C.F.R. §41.37 is presented herewith and is labeled appropriately.

This brief is in furtherance of the Final Office Action on January 13, 2006.

A Notice of Appeal was filed in this case on June 13, 2006, along with a Request for Panel Review.

The Notice of Panel Decision From Pre-Appeal Brief Review mailed on December 1, 2006 ("the Decision") indicates that claims 25-39 remain rejected. The Decision further indicates that the extendable time period for the filing of the Appellant's Brief will be reset to be one month from the mailing of the Decision.

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A *one-month* extension is provided along with the filing of the Appellant's Brief.

Accordingly, the filing of the Appellant's Brief is timely. 37 C.F.R. §1.136.

I. REAL PARTY IN INTEREST

Chugoku Kogyo Co., Ltd. is the real party in interest of the present application. An assignment of all rights in the present application to Chugoku Kogyo Co., Ltd. was executed by the inventor and recorded by the U.S. Patent and Trademark Office at **reel 010586, frame 0216**.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Thus, the status of the claims is as follows:

Claims 1-24 (Canceled);

Claims 25-39 (Rejected).

No claims are indicated within the Final Office Action to contain allowable subject matter.

Accordingly, Appellant hereby appeals the final rejection of claims 25-39 which are presented in the Claims Appendix.

IV. STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection of January 13, 2006.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The following description is provided for illustrative purposes and is not intended to limit the scope of the invention.

Claims 22-35 and 38-39 - Claims 26-35 and 38-39 are dependent upon claim 25. Claim 25 is drawn to a system of arranging the delivery of advertisements over a network, an agent managing said system, said system having an agent's server (10) that comprises:

a response measurement module (60) (Figure 1), said response measurement module (60) counting the number of specific responses made at a web site of an advertiser through an ad space (201) of a network medium; and

an administration module (70) (Figure 1), said administration module (70) making a statistical report (86) for analysis of the counted responses and delivering said statistical report through said agent's server (10) to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network (Figure 7),

wherein said web site includes (Figure 1)

an entrance page (101) which is linked from said ad space (201),

an action page (102) which is linked from the entrance page (101) and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and

an action process module (110) which responds to said specific action for processing the same,

wherein said administration module (70) produces said statistical report (86) (specification at Figure 7, and page 18 line 28 to page 19, line 2) listing

a page access number that is the number of the accesses to the entrance page (101) of said web site during a predetermined period of time (specification page 17, lines 15-16),

an action access number that is the number of accesses to said action page (102) (specification page 17, lines 17-18), and

a result number that is the number of actions made in response to an action object for necessitating processing at said action process module (110) (specification at Figure 2, and page 17, lines 19-20),

wherein said statistical report (86) includes

a proceeder rate, which is the ratio of the action access number to said page access number (specification page 17, lines 22-23), and

a completer rate, which is the ratio of the result number to said page access number (specification page 17, lines 24-25).

Claim 36 is drawn to a system of arranging the delivery of advertisements over a network, an agent managing said system, said system having an agent's server (10) that comprises:

a response measurement module (60), said response measurement module (60) counting the number of specific responses made at a web site of an advertiser through an ad space (201) of a network medium; and

an administration module (70), said administration module (70) making a statistical report for analysis of the counted responses and delivering said statistical report through said agent's server (10) to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network,

wherein said web site includes

an entrance page (101) which is linked from said ad space (201),

an action page (102) which is linked from the entrance page (101) and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and

an action process module (110) which responds to said specific action for processing the same,

wherein said administration module (70) produces said statistical report listing

a page access number that is the number of the accesses to the entrance page (101) of said web site during a predetermined period of time,

an action access number that is the number of accesses to said action page (102), and

a result number that is the number of the access to said action process module (110),

wherein said statistical report (86) includes

a proceeder rate, which is the ratio of the action access number to said page access number (specification page 17, lines 22-23), and

a completer rate, which is the ratio of the result number to said page access number (specification page 17, lines 24-25).

Claim 37 is drawn to a method of arranging the delivery of advertisements over a network, said method comprising the steps of:

counting the number of specific responses made at a web site of an advertiser through an ad space (201) of a network medium; and

making a statistical report for analysis of the counted responses and delivering said statistical report through said agent's server (10) to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network,

wherein said web site includes

an entrance page (101) that is linked from said ad space (201),

an action page (102) that is linked from the entrance page (101) and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and

an action process module (110) which responds to said specific action for processing the same,

wherein said administration module (70) produces a statistical report listing

a page access number that is the number of the accesses to the entrance page (101) of said web site during a predetermined period of time,

an action access number that is the number of accesses to said action page (102),
and

a result number that is the number of actions made in response to an action object for necessitating processing at said action process module (110);

wherein said statistical report (86) includes

a proceeder rate, which is the ratio of the action access number to said page access number (specification page 17, lines 22-23), and

a completer rate, which is the ratio of the result number to said page access number (specification page 17, lines 24-25).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration in this appeal are as follows:

Whether the Examiner erred in rejecting claims 25-39 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent No. 6,763,334.

Whether the Examiner erred in rejecting claims 25-39 under 35 U.S.C. §103 as allegedly being obvious over U.S. Patent No. 5,848,396 to Gerace in view of U.S. Patent No. 5,949,419 to Domine et al. (Domine).

This issue will be discussed hereinbelow.

VII. ARGUMENT

In the Final Office Action of January 13, 2006:

The Examiner erred in rejecting claims 25-39 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent No. 6,763,334.

The Examiner erred in rejecting claims 25-39 under 35 U.S.C. §103 as allegedly being obvious over U.S. Patent No. 5,848,396 to Gerace in view of U.S. Patent No. 5,949,419 to Domine et al. (Domine).

For at least the following reasons, Appellant submits that this rejection is both technically and legally unsound and should therefore be reversed.

For purposes of this appeal brief only, and without conceding the teachings of any prior art reference, the claims have been grouped as indicated below.

Paragraph 4 of the Final Office Action includes a rejection of claims 25-39 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over the claims of U.S. Patent No. 6,763,334.

This rejection is traversed at least for the following reasons.

As noted within paragraph 2 of the Final Office Action, a Terminal Disclaimer may be used to overcome a rejection of the claims under the judicially created doctrine of obviousness double patenting.

In this regard, please hold in abeyance the requirement for a Terminal Disclaimer until all other rejections under prior art have been addressed, and that the Examiner reevaluate the requirement for a Terminal Disclaimer at that time.

Paragraph 4 of the Final Office Action includes a rejection of claims 25-39 under 35 U.S.C. §103 as allegedly being obvious over U.S. Patent No. 5,848,396 to Gerace in view of U.S. Patent No. 5,949,419 to Domine et al. (Domine).

This rejection is traversed at least for the following reasons.

Gerace - Gerace may arguably relate to a computer network method and apparatus for providing targeting of appropriate audience based on psychographic or behavioral profiles of end users.

Gerace arguably teaches a software program 31 operated on and connected through a server 27 to the Internet for communication among the various networks 19 and/or processors 11, 13, 15, 17 and other end users connected through respective servers 25 (Gerace at column 3, lines 57-62).

Quite possibly, Figure 2 of Gerace may provide that the program 31 in its most general form has an aggregate data assembly 71, a user profiling member 73, an advertisement module 75 and a program controller 79.

Column 5, lines 26-39 of Gerace arguably provides that:

In addition, for each advertisement, advertisement module 75 (and/or user profiling member 73) records (a) the number of times and/or number of users to whom the advertisement has been displayed, (b) the number of times/users who have requested more information (via a click of a mouse on a corresponding menu selection) regarding the advertisement, and when possible (c) the number of purchases obtained through program 31's display of the advertisement. As such, advertisement module 75 holds performance data for each advertisement, and hence enables program controller 79 to provide performance reports to sponsors who log on to program 31. Various regression techniques and the like are used in the performance reports in a manner consistent with the state of the art.

Column 15, lines 11-24 of Gerace arguably teaches an equation that may include:

(#hits purchased / #hits achieved).

Gerace arguably teaches that the pricing may be dependent on the number of times the ad is viewed by users (i.e., a "hit") (Gerace at column 12, lines 11-12).

Column 15, lines 11-24 of Gerace arguably teaches an equation that may include:

(#clickthroughs purchased / # clickthroughs achieved).

Gerace arguably teaches that the pricing may be dependent on the number of times a user selects to view more information from the ad (i.e., a "click through") (Gerace at column 12, lines 12-14).

The Final Office Action contends that a Home Page of Gerace is readable upon an entrance page of the claimed invention (Final Office Action at page 3).

The Final Office Action further contends that Financial Pages, etc. of Gerace are readable upon an action page of the claimed invention (Final Office Action at page 3).

However, the claimed invention found in the present application provides for:

- a page access number that is the number of the accesses to the entrance page of said web site during a predetermined period of time,
- an action access number that is the number of accesses to said action page, and
- a result number that is the number of actions made in response to an action object for necessitating processing at said action process module.

The claimed invention additionally provide that a proceeder rate, which is the ratio of the action access number to said page access number, and a completer rate, which is the ratio of the result number to said page access number.

In this regard, paragraph 6 of the Final Office Action admits that the claimed page access number and the claimed proceeder rate are absent from within Gerace (Final Office Action at page 5).

Thus, Gerace fails to disclose, teach, or suggest a proceeder rate, which is the ratio of the action access number to said page access number, and a completer rate, which is the ratio of the result number to said page access number.

Domine - Domine arguably teaches a web browser detection and default home page modification device.

The Final Office Action refers to Domine for the features admittedly deficient from within Gerace.

Specifically, the Final Office Action relies upon column 3, lines 62 to column 4, line 12 of Domine as support for the motivation to combine the teachings of Domine with those of Gerace (Final Office Action at page 4). That passage within Domine merely provides that:

First, increased traffic at a Web Site is directly related to that Site's ability to charge increased amounts for electronic advertising. That is, companies placing advertisements for their products and/or services want to receive the maximum amount of exposure. The HOMER device maximizes potential advertiser exposure at a particular Web Site by causing individuals to start each and every browsing session at that Site. HOMER--together with further individual customization of the HOMER-adopted Home Page--creates a "captive target market" for advertisers.

However, column 3, lines 62 to column 4, line 12 of Domine fails to account for the features admittedly absent from within Gerace of claimed page access number and the claimed proceeder rate.

In this regard, there is no express teaching within Domine of either a page access number or a proceeder rate.

But as a gap filler, the Final Office Action asserts, *without providing any evidentiary support*, that "because proceeder number is a measure of the rate at which web site traffic is converted to ad viewers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to also add reporting of proceeder number to the teachings of Gerace" (Final Office Action at page 4).

In response to this assertion, the claim language found within the present application is unambiguous. Such a proclamation that the *proceeder number is a measure of the rate at which web site traffic is converted to ad viewers* is merely an attempt to reconstruct the expressed claim language. Such reconstruction is without authority under Title 35 U.S.C., Title 37 C.F.R., the M.P.E.P. and relevant case law; such reconstruction is therefore deemed improper. See M.P.E.P. 2164.08.

Additionally the teachings, suggestions or incentives supporting the obviousness-type rejection must be clear and particular. Broad conclusory statements, standing alone, are not evidence. *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

In this regard, Domine arguably teaches that it is desirable to many internet participants having a site on the world wide web to have users to connect to their web site as the initial default home page, in order to increase traffic to their web site (Domine at column 1, lines 41-44).

Domine arguably teaches that the principal use of the HOMER device in commerce is to encourage individuals who use the World Wide Web to make a particular Web Site their personal Home Page--that is, the Web Site at which they start browsing the Web, and that this is commercially desirable from the perspective of any particular Web Site because it has the effect of increasing traffic at that Web Site. (Domine at column 3, lines 56-62).

Domine arguably teaches that, first, increased traffic at a Web Site is directly related to that Site's ability to charge increased amounts for electronic advertising (Domine at column 3, lines 63-65).

Domine arguably teaches that, in each case, the HOMER device provides only for the delivery of additional traffic to a Web Site (Domine at column 4, lines 13-14).

Yet, the Final Office Action fails to show where within Domine that there is to be found a teaching that the *proceeder number is a measure of the rate at which web site traffic is converted to ad viewers*. As a result, this assertion is merely a personal conclusion that is unsupported by any objective evidence within Domine.

But even if Domine teaches that the *proceeder number is a measure of the rate at which web site traffic is converted to ad viewers*, Domine fails to disclose, teach, or suggest an administration module adapted to make a statistical report that includes a proceeder rate and a completer rate, wherein the proceeder rate is the ratio of the action access number to said page access number, and the completer rate is the ratio of the result number to said page access number.

“It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the

applicant's combination would have been obvious" (citations omitted). *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999) (rejection based upon hindsight is reversed).

This assertion amounts to nothing more than an "obvious-to-try" situation. Specifically, "an 'obvious-to-try' situation exists when a general disclosure may pique the scientist's curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued." *In re Eli Lilly & Co.*, 902 F.2d 943, 945, 14 USPQ2d 1741, 1743 (Fed. Cir. 1990). Moreover, "an invention is 'obvious to try' where the prior art gives either no indication of which parameters are critical or no direction as to which of many possible choices is likely to be successful." *Merck & Co. Inc. v. Biocraft Laboratories Inc.*, 874 F.2d 804, 806, 10 USPQ2d 1843, 1845 (Fed. Cir. 1989).

Here, the cited prior art does not contain a sufficient teaching of how to obtain the desired result, or that the claimed result would be obtained if certain directions were pursued. "Obvious to try" is not the standard under §103. *In re O'Farrell*, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988).

The Final Office Action has also failed to show that the claimed page access number and the claimed proceeder rate, which is admittedly absent from within Gerace is found within Domine. Therefore, even when Gerace is combined with the Domine, the proceeder rate and the completer rate cannot be determined from the combination thereof.

As shown hereinabove, Gerace and Domine, either individually or as a whole, fail to disclose, teach, or suggest the all features of the claimed invention.

Withdrawal of this rejection an allowance of the claims is respectfully requested.

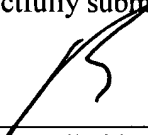

Conclusion

The claims are considered allowable for the same reasons discussed above, as well as for the additional features they recite. Reversal of the Examiner's decision is respectfully requested.

If any fee is required or any overpayment made, the Commissioner is hereby authorized to charge the fee or credit the overpayment to Deposit Account # 18-0013.

Dated: January 30, 2007

Respectfully submitted,

By  

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CLAIMS APPENDIX

1-24. (canceled).

25. (Previously presented) A system of arranging the delivery of advertisements over a network, an agent managing said system, said system having an agent's server that comprises:

a response measurement module, said response measurement module counting the number of specific responses made at a web site of an advertiser through an ad space of a network medium; and

an administration module, said administration module making a statistical report for analysis of the counted responses and delivering said statistical report through said agent's server to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network,

wherein said web site includes an entrance page which is linked from said ad space, an action page which is linked from the entrance page and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and an action process module which responds to said specific action for processing the same,

wherein said administration module produces said statistical report listing a page access number that is the number of the accesses to the entrance page of said web site during a predetermined period of time, an action access number that is the number of accesses to said action page, and a result number that is the number of actions made in response to an action object for necessitating processing at said action process module, and

wherein said statistical report includes a proceeder rate, which is the ratio of the action access number to said page access number, and a completer rate, which is the ratio of the result number to said page access number.

26. (Previously presented) The system as set forth in claim 25, wherein said defined responses include:

clicking through to said web site;

downloading a file or software from said web site;

applying for a prize offered by the advertiser on said web site;

answering to a questionnaire from the advertiser on said web site;

requesting a catalogue from the advertiser through said web site;

requesting a subscription to a newsletter from said web site;

signing up a membership of a club managed by the advertisers through said web site;

and

ordering a product or service through said web site.

27. (Previously presented) The system as set forth in claim 25, wherein said statistical report including a table showing a ratio of the number of the responses counted to the number of visits to said web site.

28. (Previously presented) The system as set forth in claim 25, wherein said proceeder rate and said completer rate being listed on a daily basis.

29. (Previously presented) The system as set forth in claim 25, wherein said proceeder rate and said completer rate being listed per said ad code when different ad codes are assigned to different campaigns.

30. (Previously presented) The system as set forth in claim 25, wherein said page access number, said action access number, and said result number are sorted on each ad code when more than one ad codes are assigned to different campaigns.

31. (Previously presented) The system as set forth in claim 25, wherein said statistical report includes a referrer table listing a ranking of referred URLs which lead to the action process module through said entrance page and said action page.

32. (Previously presented) The system as set forth in claim 25, further comprising an invitation module providing an invitation page, into which said advertiser can provide at least one entry to specify conditions of the advertisement.

33. (Previously presented) The system as set forth in claim 32, further comprising an offer module making an ad schedule listing the advertisement with the specified conditions.

34. (Previously presented) The system as set forth in claim 25, further comprising an arrangement module allocating said web site to said ad space of said network by placing the advertisement thereon.

35. (Previously presented) The system as set forth in claim 25, wherein said administration module makes said statistical report with reference to an index log file for storing index data with regard to the user requesting access to said entrance page, an action log file for storing action access data with regard to the user requesting access to said action page, and a result log file for storing action process data with regard to the user requesting the processing at said action process module.

36. (Previously presented) A system of arranging the delivery of advertisements over a network, an agent managing said system, said system having an agent's server that comprises:

a response measurement module, said response measurement module counting the number of specific responses made at a web site of an advertiser through an ad space of a network medium; and

an administration module, said administration module making a statistical report for analysis of the counted responses and delivering said statistical report through said agent's server to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network,

wherein said web site includes an entrance page which is linked from said ad space, an action page which is linked from the entrance page and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and an action process module which responds to said specific action for processing the same,

wherein said administration module produces said statistical report listing a page access number that is the number of the accesses to the entrance page of said web site during a predetermined period of time, an action access number that is the number of accesses to said action page, and a result number that is the number of the access to said action process module,

wherein said statistical report includes a proceeder rate, which is the ratio of the action access number to said page access number, and a completer rate, which is the ratio of the result number to said page access number.

37. (Previously presented) A method of arranging the delivery of advertisements over a network, said method comprising the steps of:

counting the number of specific responses made at a web site of an advertiser through an ad space of a network medium; and

making a statistical report for analysis of the counted responses and delivering said statistical report through said agent's server to the advertiser so that the advertiser can estimate the effectiveness of an advertisement on said network,

wherein said web site includes an entrance page that is linked from said ad space, an action page that is linked from the entrance page and where a user of said network may proceed to make at least one specific action of defined responses to be made by the user as a consequence of the advertisement on said network, and an action process module which responds to said specific action for processing the same,

wherein said administration module produces a statistical report listing a page access number that is the number of the accesses to the entrance page of said web site during a predetermined period of time, an action access number that is the number of accesses to said action page, and a result number that is the number of actions made in response to an action object for necessitating processing at said action process module;

wherein said statistical report includes a proceeder rate, which is the ratio of the action access number to said page access number, and a completer rate, which is the ratio of the result number to said page access number.

38. (Previously presented) The system as set forth in claim 25, wherein said administration module provides an administer page on an agent's web site, and a report form displayed on said administer page for limited access by the advertiser has a button for display a statistical report page including said proceeder rate and said completer rate.

39 (Previously presented) The system as set forth in claim 38, wherein said statistical report page has a download button which enables the advertiser to download said proceeder rate and said completer rate displayed thereon.

EVIDENCE APPENDIX

There is no other evidence which will directly affect or have a bearing on the Board's decision in this appeal.

RELATED PROCEEDINGS APPENDIX

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.